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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,320	08/08/2001	Anita Hogans Simpson	BS01-066	1966
38516	7590	04/15/2005	EXAMINER	
SCOTT P. ZIMMERMAN, PLLC PO BOX 3822 CARY, NC 27519			MARTIN, NICHOLAS A	
			ART UNIT	PAPER NUMBER

2154

DATE MAILED: 04/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Interview Summary	Application No.	Applicant(s)	
	09/923,320	SIMPSON, ANITA HOGANS	
	Examiner	Art Unit	
	Nicholas Martin	2154	

All participants (applicant, applicant's representative, PTO personnel):

(1) Nicholas Martin.

(3) Scott P. Zimmerman.

(2) John Follansbee.

(4) _____.

Date of Interview: 06 April 2005.

Type: a) ☒ Telephonic b) ☐ Video Conference
c) ☐ Personal [copy given to: 1) ☐ applicant 2) ☐ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☒ No.
If Yes, brief description: _____.

Claim(s) discussed: 1-57.


Identification of prior art discussed: Lefebvre et al.

Agreement with respect to the claims f) ☒ was reached. g) ☐ was not reached. h) ☐ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: Proposed changes to amendments as attached. Examiner stated that proposed amendments overcome primary reference (102(e)).

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE, OR THE MAILING DATE OF THIS INTERVIEW SUMMARY FORM, WHICHEVER IS LATER, TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.


 JOHN FOLLANSBEE
 SUPERVISORY PATENT EXAMINER
 TECHNOLOGY CENTER 2100

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.


 Examiner's signature, if required

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Summary of Record of Interview Requirements

Manual of Patent Examining Procedure (MPEP), Section 713.04, Substance of Interview Must be Made of Record

A complete written statement as to the substance of any face-to-face, video conference, or telephone interview with regard to an application must be made of record in the application whether or not an agreement with the examiner was reached at the interview.

Title 37 Code of Federal Regulations (CFR) § 1.133 Interviews

Paragraph (b)

In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111, 1.135. (35 U.S.C. 132)

37 CFR §1.2 Business to be transacted in writing.

All business with the Patent or Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete an Interview Summary Form for each interview held where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, or pointing out typographical errors or unreadable script in Office actions or the like, are excluded from the interview recordation procedures below. Where the substance of an interview is completely recorded in an Examiners Amendment, no separate Interview Summary Record is required.

The Interview Summary Form shall be given an appropriate Paper No., placed in the right hand portion of the file, and listed on the "Contents" section of the file wrapper. In a personal interview, a duplicate of the Form is given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephone or video-conference interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Form should be mailed promptly after the interview rather than with the next official communication.

The Form provides for recordation of the following information:

- Application Number (Series Code and Serial Number)
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (telephonic, video-conference, or personal)
- Name of participant(s) (applicant, attorney or agent, examiner, other PTO personnel, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). Note: Agreement as to allowability is tentative and does not restrict further action by the examiner to the contrary.
- The signature of the examiner who conducted the interview (if Form is not an attachment to a signed Office action)

It is desirable that the examiner orally remind the applicant of his or her obligation to record the substance of the interview of each case. It should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview.

A complete and proper recordation of the substance of any interview should include at least the following applicable items:

- 1) A brief description of the nature of any exhibit shown or any demonstration conducted,
- 2) an identification of the claims discussed,
- 3) an identification of the specific prior art discussed,
- 4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the Examiner,
- 5) a brief identification of the general thrust of the principal arguments presented to the examiner,
(The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner.)
- 6) a general indication of any other pertinent matters discussed, and
- 7) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete and accurate, the examiner will give the applicant an extendable one month time period to correct the record.

Examiner to Check for Accuracy

If the claims are allowable for other reasons of record, the examiner should send a letter setting forth the examiner's version of the statement attributed to him or her. If the record is complete and accurate, the examiner should place the indication, "Interview Record OK" on the paper recording the substance of the interview along with the date and the examiner's initials.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

SIMPSON, Anita H.

Group Art Unit: 2154**Application No.** 09/923,320**Examiner:** MARTIN, Nicholas A.**Filed:** August 8, 2001**TITLE:** "System and Method For Notifying An Offline Global Computer Network User Of An Online Interaction"

**PROPOSED RESPONSE FOR DISCUSSION WITH
EXAMINER MARTIN
ART UNIT 2154**

Hello Examiner Martin:

I am faxing a proposed amendment for discussion. I called to schedule a telephone interview, but you wanted to first confer with your supervisor. You then said you would call me back later today. I am available all day Thursday 3/31, Friday morning 4/1, and nearly any time Monday through Wednesday of next week.

You can reach me at (919) 387-6907.

Thanks,

Scott

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PROPOSED AMENDMENT TO THE CLAIMS

1. (Currently Amended) A method for notifying an offline ~~global computer network~~ user of an online ~~interaction in which the offline user could participate~~, the method comprising the steps of:

monitoring users who log in to a website;

as each user logs in, comparing specifying notification criteria of the offline user, the notification criteria specifying a particular user that logs in to the website; and

when the particular user logs in to the website, sending a notification that the particular user has logged in to the website, the notification initiating an offline communication to the offline user

~~monitoring activities occurring on the global computer network;~~

~~comparing the activities to the notification criteria; and~~

~~if the activities satisfy the notification criteria,~~

~~forwarding an offline communication to the offline user, wherein the offline communication notifies the offline user of the online interaction.~~

2. (Cancel)
3. (Currently Amended) The method of claim 1, wherein the website ~~online interaction~~ is a chat room and the notification criteria further comprise at least one of:

a number of users logged into the chat room,

~~a particular user logs into the chat room; and~~

a request that the offline user log into the chat room, wherein the request is sent by a user logged into the chat room.

4. (Currently Amended) The method of claim 1, wherein the website ~~online interaction~~ is a game site and the notification criteria further comprise at least one of:

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a number of users logged into the game site,
~~a particular user logs into the game site, and~~
a request that the offline user log into the game site, wherein the request is sent by
a user logged into the game site.

5. (Currently Amended) The method of claim 1, wherein the website online interaction is an auction site and the notification criteria comprise entry of a bid that exceeds a high bid submitted by the offline user ~~instant messaging service and the notification criteria comprise an event in which a buddy from a buddy list of the offline user logs onto the instant messaging service.~~
6. (Currently Amended) The method of claim 1, wherein the website online interaction is an auction site and the notification criteria comprise ~~at least one of: entry of a bid that exceeds a high bid submitted by the offline user, and~~ a number of bids submitted within a certain duration.
7. (Currently Amended) The method of claim 12, further comprising reporting the indication to another offline user ~~wherein the online interaction is a call over the global computer network and the notification criteria comprise an event in which the offline subscriber receives an unanswered call over the global computer network.~~
8. (Currently Amended) The method of claim 1, further comprising at least one of storing wherein the step of specifying further comprises specifying contact information of the offline user, and the step of forwarding comprises retrieving the contact information of the offline user, and sending forwarding the offline communication to the offline user in accordance with the contact information.
9. (Original) The method of claim 8, wherein the contact information comprises a communication device type and an address of the communication device.

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10. (Original) The method of claim 8, wherein the contact information comprises a plurality of communication device types of the offline user, addresses for each of the plurality of communication device types, and an order in which to attempt the plurality of communication device types.
11. (Currently Amended) The method of claim 1 ~~8~~, wherein the step of sending forwarding the offline communication comprises sending forwarding the offline communication to one of a wireline telephone, a wireless telephone, a caller identification device, a wireless access protocol device, a one-way pager, and an interactive pager.
12. (Currently Amended) The method of claim 1, further comprising the steps of:
- receiving an indication ~~from the offline~~ user as to whether the offline user will log in to the website ~~join the online interaction~~; and
- reporting the indication to an online user ~~users with whom the online interaction would take place~~.
13. (Currently Amended) The method of claim 12, wherein the step of sending forwarding the offline communication comprises sending forwarding the offline communication to one of a wireline telephone and a wireless telephone,
- wherein the step of receiving the indication comprises receiving input of the offline user through an interactive voice response unit, and
- wherein the step of reporting the indication comprises transmitting the indication to the online user ~~users~~ through a ~~the~~ global computer network.
14. (Currently Amended) The method of claim 13, wherein the step of receiving the indication comprises receiving audio input of the offline user and converting the audio input to text for transmission through the global computer network to the online user ~~users~~.

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15. (Currently Amended) The method of claim 13, wherein the step of receiving the indication comprises receiving audio input of the offline user, recording the audio input as in a digital audio file, and transmitting the digital audio file through the global computer network to the online user users.
16. (Currently Amended) The method of claim 12, wherein the step of sending forwarding the offline communication comprises sending forwarding the offline communication to one of an interactive pager and a wireless access protocol device,
wherein the step of receiving the indication comprises receiving input of the offline user from the interactive pager or the wireless access protocol device, and
wherein the step of reporting the indication comprises transmitting the indication to the online user users through the global computer network.
17. (Original) The method of claim 16, wherein the input comprises one of a standard message and a customized message.
18. (Currently Amended) The method of claim 1, wherein the notification comprises offline communication states the notification criteria, ~~states that the notification criteria has been satisfied, and states~~ a time and a date that the notification criteria was satisfied.
19. (Currently Amended) The method of claim 1 ~~8~~, further comprising the step of requiring the offline user to provide a passcode before forwarding the offline communication.
20. (Currently Amended) A computer system ~~for~~ providing notification of an online interaction occurring on a global computer network, the computer system performing the steps of comprising:

monitoring users who log in to a website;

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as each user logs in, comparing notification criteria of an offline user, the notification criteria specifying a particular user that logs in to the website; and

when the particular user logs in to the website, sending a notification that the particular user has logged in to the website, the notification initiating an offline communication to the offline user

~~(a) — a plurality of network users, wherein the plurality of network users performs activities on the global computer network related to the online interaction;~~

~~(b) — an offline global computer network user; and~~

~~(c) — a service provider in communication with the plurality of network users and the offline global computer network user,~~

~~wherein the service provider is in communication with the plurality of network users through the global computer network;~~

~~wherein the service provider has a communication interface through which the service provider is in communication with the offline global computer network user;~~

~~wherein the service provider is adapted to monitor the activities of the plurality of network users;~~

~~wherein the service provider is adapted to compare the activities to criteria for notifying the offline global computer network user of the online interaction; and~~

~~wherein the service provider is adapted to notify the offline global computer network user through the communication interface if the activities satisfy the criteria.~~

21. (Currently Amended) The computer system of claim 20, wherein the website is a chat room and the notification criteria further comprise at least one of i) a number of users logged into the chat room and ii) a request that the offline user log into the chat room, wherein the request is sent by a user logged into the chat room ~~communication interface is adapted to notify the offline global computer network user through one of a wireline telephone, a wireless telephone, a caller identification device, a wireless access protocol device, a one-way pager, and an interactive pager.~~

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22. (Currently Amended) The computer system of claim 20, wherein the website is a game site and the notification criteria further comprise at least one of i) a number of users logged into the game site and ii) a request that the offline user log into the game site, wherein the request is sent by a user logged into the game site ~~service provider is adapted to receive a response from the offline global computer network user, and to transmit the response to at least one of the plurality of network users.~~
23. (Currently Amended) The computer system of claim 20, wherein the website is an auction site and the notification criteria comprise entry of a bid that exceeds a high bid submitted by the offline user ~~communication interface is adapted to notify the offline global computer network user through one of a wireline telephone and a wireless telephone, wherein the communication interface includes an interactive voice response unit with which to receive a response from the offline global computer network user, and wherein the service provider is adapted to transmit the response to at least one of the plurality of network users.~~
24. (Currently Amended) The computer system of claim 20, wherein the computer further performs at least one of the following steps: i) storing contact information of the offline user, ii) retrieving the contact information of the offline user, and iii) sending the offline communication to the offline user in accordance with the contact information ~~activities comprise at least one of chat room activity, game site activity, instant messaging activity, auction activity, and activity related to calls over the global computer network.~~
25. (Currently Amended) The computer system of claim 20 24, wherein the contact information comprises a communication device type and an address of the communication device ~~criteria comprise one of:~~
a number of users logged into one of a chat room and a game site,
a particular user logs into one of a chat room and a game site,
a request that the offline global computer network user log into one of a chat room and a game site,

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~~an event in which a buddy from a buddy list of the offline global computer network user logs onto an instant messaging service;~~
~~entry of an auction bid that exceeds a high bid submitted by the offline global computer network user;~~
~~a number of bids submitted to an auction within a certain duration; and~~
~~an event in which the offline subscriber receives an unanswered call over the global computer network.~~

26. (Currently Amended) The computer system of claim 20 24, wherein the contact information comprises a plurality of communication device types of the offline user, addresses for each of the plurality of communication device types, and an order in which to attempt the plurality of communication device types further comprising a database accessible to the service provider, wherein the database contains the criteria.
27. (Currently Amended) The computer system of claim 26 24, wherein the step of sending the offline communication comprises sending the offline communication to one of a wireline telephone, a wireless telephone, a caller identification device, a wireless access protocol device, a one-way pager, and an interactive pager database contains contact information defining how to notify the offline global computer network user.
28. (Currently Amended) The computer system of claim 27 20, wherein the contact information comprises a communication device type and an address of the communication device computer further performs the following steps:
- receiving an indication f as to whether the offline user will log in to the website;
and
reporting the indication to an online user.

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29. (Currently Amended) The computer system of claim 26 24, wherein the step of sending the offline communication comprises sending the offline communication to one of a wireline telephone and a wireless telephone,
wherein the step of receiving the indication comprises receiving input of the offline user through an interactive voice response unit, and
wherein the step of reporting the indication comprises transmitting the indication to the online user through a global computer network database contains a passcode that the offline global computer network user must provide to receive the notification.
30. (Currently Amended) A system for providing notification of an online interaction occurring on a global computer network, the system ~~comprising~~ performing the steps of:
monitoring users who log in to a website;
as each user logs in, comparing notification criteria of an offline user, the notification criteria specifying a particular user that logs in to the website; and
when the particular user logs in to the website, sending an offline communication to the offline user, the offline communication notifying the offline user that the particular user has logged in to the website

(a) ~~an offline global computer network user;~~
(b) ~~a plurality of network users in communication with the global computer network;~~
(c) ~~a site in communication with the plurality of network users through the global computer network,~~
wherein the plurality of network users perform activities related to the online interaction on the site,
wherein the site is adapted to monitor the activities of the plurality of network users, and
wherein the site is adapted to compare the activities to criteria for notifying the offline global computer network user of an online interaction; and

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~~(d) — a service provider in communication with the site and the offline global computer network user,~~

~~wherein the service provider is in communication with the site through the global computer network,~~

~~wherein the service provider has a communication interface through which the service provider is in communication with the offline global computer network user, and~~

~~wherein the site is adapted to notify the service provider if the activities satisfy the criteria in response to which the service provider is adapted to notify the offline global computer network user through the communication interface.~~

31. (Currently Amended) The system of claim 30, wherein the website is a chat room and the notification criteria further comprise at least one of i) a number of users logged into the chat room and ii) a request that the offline user log into the chat room, wherein the request is sent by a user logged into the chat room further comprising a database accessible to the site, wherein the database contains the criteria.
32. (Currently Amended) The system of claim 34 ~~30~~, wherein the website is a game site and the notification criteria further comprise at least one of i) a number of users logged into the game site and ii) a request that the offline user log into the game site, wherein the request is sent by a user logged into the game site ~~database contains contact information of the offline global computer network user, and wherein the site passes the contact information to the service provider.~~
33. (Currently Amended) The system of claim 34 ~~30~~, wherein the website is an auction site and the notification criteria comprise entry of a bid that exceeds a high bid submitted by the offline user further comprising a second database accessible to the service provider, wherein the second database contains contact information of the offline global computer network user.

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34. (Currently Amended) The system of claim 30, wherein the system further performs at least one of the following steps: i) storing contact information of the offline user, ii) retrieving the contact information of the offline user, and iii) sending the offline communication to the offline user in accordance with the contact information ~~communication interface is adapted to notify the offline global computer network user through one of a wireline telephone, a wireless telephone, a caller identification device, a wireless access protocol device, a one-way pager, and an interactive pager.~~
35. (Currently Amended) The system of claim 30 34, wherein the contact information comprises a communication device type and an address of the communication device ~~service provider is adapted to receive a response from the offline global computer network user, and to transmit the response to at least one of the plurality of network users.~~
36. (Currently Amended) The system of claim 30 34, wherein the contact information comprises a plurality of communication device types of the offline user, addresses for each of the plurality of communication device types, and an order in which to attempt the plurality of communication device types ~~communication interface is adapted to notify the offline global computer network user through one of a wireline telephone and a wireless telephone,~~
~~wherein the communication interface includes an interactive voice response unit with which to receive a response from the offline global computer network user, and~~
~~wherein the service provider is adapted to transmit the response to at least one of the plurality of network users.~~
37. (Currently Amended) The system of claim 30 34, wherein the step of sending the offline communication comprises sending the offline communication to one of a wireline telephone, a wireless telephone, a caller identification device, a wireless access protocol device, a one-way pager, and an interactive pager ~~activities comprise at least one of chat room activity, game site activity, instant messaging activity, auction activity, and activity related to calls over the global computer network.~~

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38. (Currently Amended) The system of claim 30, wherein the system further performs the following steps:

receiving an indication from the offline user as to whether the offline user will log in to the website; and

reporting the indication to an online user

~~criteria comprise one of:~~

~~a number of users logged into one of a chat room and a game site;~~

~~a particular user logs into one of a chat room and a game site;~~

~~a request that the offline global computer network user log into one of a chat room and a game site;~~

~~an event in which a buddy from a buddy list of the offline global computer network user logs onto an instant messaging service;~~

~~entry of an auction bid that exceeds a high bid submitted by the offline global computer network user;~~

~~a number of bids submitted to an auction within a certain duration; and~~

~~an event in which the offline subscriber receives an unanswered call over the global computer network.~~

39. (Currently Amended) The system of claim ~~30~~ 38, wherein the step of sending the offline communication comprises sending the offline communication to one of a wireline telephone and a wireless telephone.

wherein the step of receiving the indication comprises receiving input of the offline user through an interactive voice response unit; and

wherein the step of reporting the indication comprises transmitting the indication to the online user through a global computer network

~~further comprising a plurality of offline global computer network users;~~

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~~wherein the service provider is in communication with the plurality of offline global computer network users through the communication interface,~~

~~wherein the site contains a list of subscribers who want to receive the notification of the online interaction, wherein the subscribers are part of the plurality of offline global computer network users,~~

~~wherein the criteria comprises a request from the plurality of network users for at least one of the subscribers to log onto the site, and~~

~~wherein the service provider is adapted to notify the at least one of the subscribers through the communication interface.~~

40. (Currently Amended) A system for notifying an offline ~~global computer network~~ user of an online interaction ~~in which the offline user could participate~~, the system comprising:
- (a) a means for retrieving specifying notification criteria of the offline user, the notification criteria specifying a particular user that logs in to a website;
 - (b) a means for monitoring users who log in to the website activities occurring on the global computer network;
 - (c) a means for comparing the logged in users activities to the notification criteria; and
 - (d) a means for sending a notification that the particular user has logged in to the website, the notification initiating an offline communication to the offline user forwarding an offline communication to the offline user, wherein the offline communication notifies the offline user of the online interaction.
41. (Currently Amended) The system method of claim 40, wherein the website online interaction is one of a chat room, a game site, ~~an instant messaging service, and an auction, and a call made over the global computer network.~~
42. (Currently Amended) A method for notifying an offline ~~global computer network~~ user of an interaction in which the offline user could participate, wherein the interaction occurs

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on a website ~~global computer network site that facilitates real time online interactions between two or more users~~, the method comprising the steps of:

retrieving ~~establishing~~ conditions under which to notify the offline user, the conditions specifying a particular user that logs in to the website;

~~monitoring activities on the site~~ users who log in to the website;

comparing the logged in users activities to the conditions; and

if the activities satisfy the conditions, sending a notification that the particular user has logged in to the website, the notification initiating an offline communication to the offline user ~~notifying the offline user via an offline communication of the interaction~~.

43. (Currently Amended) The method of claim 42, wherein the website is one of a chat site, a game site, and an auction site.
44. (Currently Amended) The method of claim 42, ~~wherein the global computer network is the Internet~~ further comprising at least one of the following steps: i) storing contact information of the offline user, ii) retrieving the contact information of the offline user, and iii) sending the offline communication to the offline user in accordance with the contact information.
45. (Currently Amended) The method of claim 42, wherein the conditions ~~are~~ further comprise one of:
- when the number of users logged into the site exceed a preset amount,
~~when a particular user logs into the site~~, and
when a user logged into the site requests that the offline user log into the site.
46. (Currently Amended) The method of claim 42 ~~44~~, wherein the offline communication is one of a wireline telephone call, a wireless telephone call, a message sent to a caller

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identification device, a message sent to a wireless access protocol device, a message sent to a one-way pager, and a message sent to an interactive pager.

47. (Currently Amended) The method of claim 42, further comprising the steps of:

receiving an indication ~~from the offline user~~ as to whether the offline user will join the interaction; and

reporting the indication to users logged into the website.

48. (Currently Amended) A method for notifying an offline ~~global computer network~~ user of an interaction in which the offline user could participate, wherein the interaction occurs on an instant messaging service, the method comprising the steps of:

associating a group of users with the offline user;

monitoring whether a particular user logs ~~users of the group of users log~~ into the instant messaging service;

if a the particular user of the group users logs into the instant messaging service, then sending a notification that the particular user has logged in to the instant messaging service, the notification initiating an offline communication to the offline user notifying the offline user via an offline communication of the interaction with the user;

receiving an indication as to whether the offline user will join the instant messaging service; and

reporting the indication to users logged into the instant messaging service.

49. (Cancel)

50. (Cancel)

51. (Currently Amended) A method for notifying an offline ~~global computer network~~ user of activities occurring on an auction website, the method comprising the steps of:

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~~retrieving establishing~~ conditions under which to notify the offline user, the conditions specifying a particular user that logs in to the auction website;

~~monitoring the activities on the~~ users who log in to the auction website;

~~comparing the activities logged in users~~ to the conditions; and

if the activities satisfy the conditions, sending a notification that the particular user has logged in to the auction website, the notification initiating an offline communication to the offline user notifying the offline user of the activities via one of a telephone and a caller identification device.

52. (Original) The method of claim 51, wherein the conditions are one of:

when a bid is entered that exceeds a high bid of the offline user, and

when the number of bids entered with a duration exceeds a preset amount.

53. (Currently Amended) The method of claim 51, further comprising the steps of:

receiving an indication ~~from the offline user~~ as to whether the offline user will log onto the auction website and participate in the activities; and

reporting the indication to a user ~~users~~ logged into the auction website.

54. (Currently Amended) The method of claim 51, further comprising the step of ~~steps of:~~

~~receiving a high bid from the offline user via the one of a telephone and a caller identification device; and~~

reporting ~~the~~ a high bid from the offline user to users logged into the auction website.

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55. (Currently Amended) A method for notifying ~~an offline global computer network~~ a user of a call over a global computer network to the ~~offline~~ user, the method comprising the steps of:
- monitoring ~~the global computer network~~ for calls to a the network address of the ~~offline~~ user; and
 - if a call from a calling party to the network address is unanswered, notifying the ~~offline~~ user of the unanswered call via an offline communication;
 - receiving an indication from the user as to whether the user will accept the call to the network address; and
 - reporting the indication to the calling party.
56. (Original) The method of claim 55, wherein the offline communication is one of a wireline telephone call, a wireless telephone call, a message sent to a caller identification device, a message sent to a wireless access protocol device, a message sent to a one-way pager, and a message sent to an interactive pager.
57. (Cancel)

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REMARKS

In response to the Office Action dated January 27, 2005, the Assignee respectfully requests reconsideration based on the above claim amendments and the following remarks. Assignee respectfully submits that the pending claims distinguish over the cited art of record.

The United States Patent and Trademark Office (the "Office") rejected claims 1-2, 7-13, 15-18, 20-24, 26-28, 30-37, 39-44, 46-51, and 55-57 under 35 U.S.C. § 102 (e) as being anticipated by Published United States Patent Application 2002/0046299 to Lefebvre *et al.* Claim 3 was rejected under 35 U.S.C. § 103 (a) as being obvious over *Lefebvre* in view of Published United States Patent Application 2001/0051989 to Moncreiff. Claims 4, 19, and 29 were rejected under 35 U.S.C. § 103 (a) as being obvious over *Lefebvre* in view of Published United States Patent Application 2002/0028708 to Busch *et al.* Claim 5 was rejected under 35 U.S.C. § 103 (a) as being obvious over *Lefebvre* in view of Published United States Patent Application 2002/0111813 to Capps. Claims 6 and 52-54 were rejected under 35 U.S.C. § 103 (a) as being obvious over *Lefebvre* in view of Published United States Patent Application 2004/0073507 to Scott. Claim 14 was rejected under 35 U.S.C. § 103 (a) as being obvious over *Lefebvre* in view of Published United States Patent Application 2002/0124100 to Adams. The Assignee shows, however, that the amended claims are patentably distinguishable over *Lefebvre*, *Moncreiff*, *Busch*, *Capps*, *Scott*, and/or *Adams*, whether considered singularly or in any combination.

Rejection of Claims under 35 U.S.C. § 102 (e)

The United States Patent and Trademark Office (the "Office") rejected claims 1-2, 7-13, 15-18, 20-24, 26-28, 30-37, 39-44, 46-51, and 55-57 under 35 U.S.C. § 102 (e) as being anticipated by Published United States Patent Application 2002/0046299 to Lefebvre *et al.* A claim is anticipated only if each and every element is found in a single prior art reference. *See Verdegall Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q. 2d (BNA) 1051, 1053 (Fed. Cir. 1987). *See also* DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2131 (orig. 8th Edition) (hereinafter "M.P.E.P."). As the Assignee shows, the amended claims are patentably distinguishable over *Lefebvre*. The reference to *Lefebvre*

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does not anticipate the claims, so the Assignee respectfully requests that Examiner Martin remove the 35 U.S.C. § 102 (e) rejection of the claims.

The pending claims have been amended. All the claims now recite methods, computers, or other systems that notify an offline user of an online user. As users log in to a website, the offline user's notification criteria are compared. The notification criteria specify a particular user that logs in to the website. When that particular user logs in, a notification is sent. A "clean" version of claim 1, for example, is reproduced below.

1. A method for notifying an offline user of an online user, the method comprising the steps of:

monitoring users who log in to a website;
as each user logs in, comparing notification criteria of the offline user, the notification criteria specifying a particular user that logs in to the website; and
when the particular user logs in to the website, sending a notification that the particular user has logged in to the website, the notification initiating an offline communication to the offline user.

All the other independent claims include similar features.

Lefebvre does not anticipate the claims. As Examiner Martin noticed, *Lefebvre* is completely silent to monitoring users that log in to a website and sending a notification when a particular user that logs in to the website. Because *Lefebvre* fails to contemplate such features, the Assignee respectfully requests that Examiner Martin remove the 35 U.S.C. § 102 (e) rejection of the claims.

Rejection of Claim 3 under 35 U.S.C. § 103 (a)

Claim 3 was rejected under 35 U.S.C. § 103 (a) as being obvious over *Lefebvre* in view of Published United States Patent Application 2001/0051989 to Moncreiff. If the Office wishes to establish a *prima facie* case of obviousness, three criteria must be met: 1) the Examiner must identify "some suggestion or motivation...to modify the reference"; 2) the Examiner must identify "a reasonable expectation of success"; and 3) "the prior art reference must teach or

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suggest all the claim limitations.” DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8th Edition) (hereinafter “M.P.E.P.”). The Assignee shows, however, that the attempted combination of *Lefebvre* and *Moncreiff* fails to teach or suggest all the features recited in the independent claims. The Assignee also shows that Examiner Martin has failed to properly present a *prima facie* case for obviousness. The Assignee thus respectfully requests that Examiner Martin remove the § 103 (a) rejection.

1. The *Prima Facie* Case of Obviousness Fails to Teach or Suggest All the Claimed Features

The independent claims are not obvious. All the independent claims recite methods, computers, or other systems that notify an offline user of an online user. As users log in to a website, the offline user’s notification criteria are compared. The notification criteria specify a particular user that logs in to the website. When that particular user logs in, a notification is sent.

The Examiner’s proposed combination of *Lefebvre* and *Moncreiff* fails to teach or suggest such features. The proposed combination of *Lefebvre* and *Moncreiff* is completely silent to the features recited in the independent claims. No where does *Lefebvre* and/or *Moncreiff* teach or suggest: “monitoring users who log in to a website; as each user logs in, comparing notification criteria of the offline user, the notification criteria specifying a particular user that logs in to the website; and when the particular user logs in to the website, sending a notification that the particular user has logged in to the website, the notification initiating an offline communication to the offline user.”

Examiner Martin is correct — several times *Moncreiff* discusses the number of users in a chat room. See, e.g., Published United States Patent Application 2001/0051989 to Moncreiff (Dec. 13, 2001) at paragraphs [0009], [0045], [0050], [0057], [0058], and [0059]. No where, however, does *Moncreiff* monitor when a particular user logs in to a website and then send a notification that the particular user has logged in to the website. Examiner Martin points to paragraph [0003], but the Assignee finds no such teaching or suggestion. Paragraph [0003] reviews the basics of chat room use, such as “relaying” text between “occupants” of the chat

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room. Paragraph [0003] also describes how two users can arrange to "meet" in a private chat room for private conversation. Neither paragraph [0003], nor *Moncreiff in toto*, teach or suggest the features recited in the independent claims. The Assignee thus respectfully requests that Examiner Martin remove the § 103 (a) rejection.

Moncreiff is also silent to other features. Claim 3 also recites that the notification criteria further comprise "a request that the offline user log into the chat room, wherein the request is sent by a user logged into the chat room." Examiner Martin points to paragraph [0012], yet, again, the Assignee finds no such teaching or suggestion. Paragraph [0012] discusses "keying" a website to a broadcast channel. Neither paragraph [0012], nor *Moncreiff in toto*, teach or suggest the features recited in claim 3. The Assignee thus respectfully requests that Examiner Martin remove the § 103 (a) rejection.

2. The *Prima Facie* Case of Obviousness Must Fail for Lack of Teaching, Suggestion, or Motivation

The Examiner's attempted *prima facie* case for obviousness fails to establish any teaching, suggestion, or motivation. If the Office wishes to establish a *prima facie* case of obviousness, three criteria must be met: 1) combining prior art requires "some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill"; 2) there must be a reasonable expectation of success; and 3) all the claimed limitations must be taught or suggested by the prior art. DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8th Edition) (hereinafter "M.P.E.P."). **When the motivation to combine the teachings is not apparent, the Examiner has a duty to explain why the combination is proper.** See *id.* at 2142; see also *In re Skinner*, 2 U.S.P.Q.2d (BNA) 1788 (Bd. Pat. App. & Inter. 1986) (emphasis added). Even if the references teach all aspects of the claimed invention, the Examiner's *prima facie* case must still include some objective reason to combine the references. See M.P.E.P. at § 2143.01; see also *In re Levengood*, 28 U.S.P.Q.2d (BNA) 1300 (Bd. Pat. App. & Inter. 1993) (emphasis added).

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Here, the office action fails to identify any teaching, suggestion, or motivation to combine the cited references. The Examiner makes no effort to explain why the proposed combination of *Lefebber* and *Moncreiff* is proper. Because the Examiner has failed to carry the initial burden of factually supporting the *prima facie* conclusion of obviousness, the Examiner is required to either i) supplement the rejection in the next office action or ii) remove the rejection. If the Examiner chooses to supplement the rejection in the next office action, that next office action cannot be made final without violating the Assignee's Due Process rights.

3. The *Prima Facie* Case of Obviousness Must Fail for Lack of Expectation of Success

The Examiner's attempted *prima facie* case for obviousness fails to establish any expectation of success. If the Office wishes to establish a *prima facie* case of obviousness, the Examiner must identify a reasonable expectation of success. See DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8th Edition) (hereinafter "M.P.E.P.").

Here, the office action fails to identify any expectation of success. The Examiner makes no effort to explain why one of ordinary skill in the art would expect success when attempting to combine *Lefebber* and *Moncreiff*. Because the Examiner has failed to carry the initial burden of factually supporting the *prima facie* conclusion of obviousness, the Examiner is required to remove the rejection.

Rejection of Claims 4, 19 & 29 under 35 U.S.C. § 103 (a)

Claims 4, 19, and 29 were rejected under 35 U.S.C. § 103 (a) as being obvious over *Lefebber* in view of Published United States Patent Application 2002/0028708 to Busch *et al.* The Examiner's proposed combination of *Lefebber* and *Busch*, however, again fails to teach or suggest the features recited in the independent claims. No where does *Lefebber* and/or *Busch* teach or suggest: "monitoring users who log in to a website; as each user logs in, comparing notification

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criteria of the offline user, the notification criteria specifying a particular user that logs in to the website; and when the particular user logs in to the website, sending a notification that the particular user has logged in to the website, the notification initiating an offline communication to the offline user." Examiner Martin points to paragraph [0039] of *Busch*, but the Assignee finds no such teaching or suggestion. Paragraph [0039] discusses inputting a username and password to log in to a gaming website. Neither paragraph [0039], nor *Busch in toto*, teach or suggest the features recited in claims 4, 19, and 29. The Assignee thus respectfully requests that Examiner Martin remove the § 103 (a) rejection.

The Examiner's *prima facie* case must fail for other reasons. As this response explains above, the Examiner's attempted *prima facie* case for obviousness fails to establish any teaching, suggestion, or motivation. The Examiner's attempted *prima facie* case for obviousness also fails to establish any expectation of success. Because the Examiner has failed to carry the initial burden of factually supporting the *prima facie* conclusion of obviousness, the Examiner is required to remove the rejection.

Rejection of Claim 5 under 35 U.S.C. § 103 (a)

Claim 5 was rejected under 35 U.S.C. § 103 (a) as being obvious over *Lefebvre* in view of Published United States Patent Application 2002/0111813 to Capps. Claim 5, however, has been amended and no longer recites instant messaging features. Claim 5, instead, now recites notification criteria for an auction website. The rejection is now moot.

Rejection of Claims 6 & 52-54 under 35 U.S.C. § 103 (a)

Claims 6 and 52-54 were rejected under 35 U.S.C. § 103 (a) as being obvious over *Lefebvre* in view of Published United States Patent Application 2004/0073507 to Scott. The Examiner's proposed combination of *Lefebvre* and *Scott*, however, again fails to teach or suggest the features recited in the independent claims. No where does *Lefebvre* and/or *Scott* teach or suggest: "*monitoring users who log in to a website; as each user logs in, comparing notification criteria of the offline user, the notification criteria specifying a particular user that logs in to the*

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website; and when the particular user logs in to the website, sending a notification that the particular user has logged in to the website, the notification initiating an offline communication to the offline user." Neither *Lefebber* nor *Scott* teach or suggest the features recited in claims 6 and 52-54. The Assignee thus respectfully requests that Examiner Martin remove the § 103 (a) rejection.

The Examiner's *prima facie* case must fail for other reasons. As this response explains above, the Examiner's attempted *prima facie* case for obviousness fails to establish any teaching, suggestion, or motivation. The Examiner's attempted *prima facie* case for obviousness also fails to establish any expectation of success. Because the Examiner has failed to carry the initial burden of factually supporting the *prima facie* conclusion of obviousness, the Examiner is required to remove the rejection.

Rejection of Claim 14 under 35 U.S.C. § 103 (a)

Claim 14 was rejected under 35 U.S.C. § 103 (a) as being obvious over *Lefebber* in view of Published United States Patent Application 2002/0124100 to Adams. The Examiner's proposed combination of *Lefebber* and *Adams*, however, again fails to teach or suggest the features recited in the independent claims. No where does *Lefebber* and/or *Adams* teach or suggest: "*monitoring users who log in to a website; as each user logs in, comparing notification criteria of the offline user, the notification criteria specifying a particular user that logs in to the website; and when the particular user logs in to the website, sending a notification that the particular user has logged in to the website, the notification initiating an offline communication to the offline user.*" Neither *Lefebber* nor *Adams* teach or suggest the features recited in claim 14. The Assignee thus respectfully requests that Examiner Martin remove the § 103 (a) rejection.

The Examiner's *prima facie* case must fail for other reasons. As this response explains above, the Examiner's attempted *prima facie* case for obviousness fails to establish any teaching, suggestion, or motivation. The Examiner's attempted *prima facie* case for obviousness also fails to establish any expectation of success. Because the Examiner has failed to carry the initial

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burden of factually supporting the *prima facie* conclusion of obviousness, the Examiner is required to remove the rejection.

If any issues remain outstanding, the Office is requested to contact the undersigned at (919) 387-6907 or scott@scottzimmerman.com.

Respectfully submitted,

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